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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,261	12/02/2005	Kun-Kook Lee	BJS-3260-29	1787
23117	7590	07/18/2008	EXAMINER	
NIXON & VANDERHYE, PC			CHEN, CATHERYNE	
901 NORTH GLEBE ROAD, 11TH FLOOR				
ARLINGTON, VA 22203			ART UNIT	PAPER NUMBER
			1655	
			MAIL DATE	DELIVERY MODE
			07/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/553,261	LEE ET AL.	
	Examiner	Art Unit	
	CATHERYNE CHEN	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 April 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-10 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-7,9 and 10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>Oct. 11, 2005</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

The Amendments filed on April 9, 2008 has been received and entered.

Currently, Claims 2-10 are pending. Claims 2-7, 9-10 are examined on the merits. Claim 1 is canceled.

Applicant's request for signed IDS is sent with this Office action.

Election/Restrictions

Applicant's election of compound formula III of Claim 9 in the reply filed on Oct. 25, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 8 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Oct. 25, 2007.

Response to Arguments

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cho (JP 01233207 A) for the reasons set forth in the previous Office Action, which is set forth below. All of Applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive.

Applicant argues that there is unexpected result from the combination of the extracts for enhancing proliferation of keratinocyte and fibroblast, and skin elasticity.

In response to applicant's argument that the combination of the extracts result in enhancing proliferation of keratinocyte and fibroblast, and skin elasticity, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-7, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (JP 01233207 A) and Ribier et al. (US 5658575) for the reasons set forth in the previous Office Action, which is set forth below. All of Applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive.

Applicant argues that the application is to facial skin, unexpected superior results, the references do not teach extract from a seed of Areca catechu and Glycyrrhiza glabra.

In response to applicant's argument that the application is to facial skin, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the

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differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Here, the Applicant's claim is toward a composition, not a method of using the composition.

Cho teaches a hair tonic with alcohol, water extracts of Kanzo (root of *Glycyrrhiza glabra*) and Binrou (seed of Areca catechu) (Abstract). Thus, the claim limitations are taught.

In response to Applicant claim that there is superior unexpected results, the experiments from Table 2, 3, and 6 do not have standards of deviation to show statistical significance of the data. In addition, the combination of *G. glabra* and *A. catechu* is taught by the prior art of Cho. Unexpected results must stem from a difference between the prior art and the claimed invention. Since the prior art teaches the combination of *G. glabra* and *A. catechu*, there is no difference, either expected or unexpected between the two. Therefore, the claim of unexpected result is not convincing.

Claims 2-7, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albacarys et al. (US 6338855 B1) for the reasons set forth in the previous Office Action, which is set forth below. All of Applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive.

Applicant argues that the application is to facial skin, unexpected superior results, the references do not teach extract from a seed of Areca catechu and *Glycyrrhiza glabra*.

Albacarys et al. teaches skin or hair care composition with areca catechu extract (column 22, line 66-67), licorice extract (column 23, line 20), phytantriol (column 41, line 44), glycerine (column 55, line 65), disposition aid can be nonionic (column 29, lines 6), skin care emulsions and mixtures thereof (Claim 4). Licorice is Glycyrrhiza glabra (see <http://en.wikipedia.org/wiki/Liquorice>).

In response to applicant's argument that the application is to facial skin, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Here, the Applicant's claim is toward a composition, not a method of using the composition.

In response to Applicant claim that there is superior unexpected results, the experiments from Table 2, 3, and 6 do not have standards of deviation to show statistical significance of the data. In addition, the combination of G. glabra and A. catechu is taught by the prior art of Cho. Unexpected results must stem from a difference between the prior art and the claimed invention. Since the prior art teaches the combination of G. glabra and A. catechu, there is no difference, either expected or unexpected between the two. Therefore, the claim of unexpected result is not convincing.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERYNE CHEN whose telephone number is (571)272-9947. The examiner can normally be reached on Monday to Friday, 9-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Catheryne Chen
Examiner Art Unit 1655

/Susan Coe Hoffman/
Primary Examiner, Art Unit 1655